

REMARKS

Claims 1-4, 6-10, 12-16 and 18-21 were pending in the present application. Claim 8 is cancelled herein, and claims 1, 13, 19, and 20 have been amended. Claims 23-25 have been added. Accordingly, claims 1-4, 6, 7, 9, 10, 12-16, 18-21, and 23-25 are currently pending. No new matter has been added. Applicants respectfully request reconsideration of the claims in view of the following remarks.

As an initial matter, Applicants thank the Examiner for taking time to discuss the present application on June 22, 2010. Claim 1 was discussed with respect to the rejection under 35 U.S.C. § 112, first paragraph, and with respect to the teachings of U.S. Patent Publication No. 2003/0027554 (hereinafter “Haumont”) and U.S. Patent Publication No. 2002/0127995 (hereinafter “Faccinn”). In particular, the asserted teachings of the cited references with regard to “a volume limit threshold” and “transmitting said accumulated billable data . . . from said GGSN to said first SGSN” were discussed.

The Specification was objected to under 35 U.S.C. § 132(a) as assertedly introducing new matter due to the amendments to the Specification submitted in Applicants’ Amendment dated July 24, 2009. In response, Applicants respectfully direct the Examiner’s attention to claim 7 as originally filed. Claim 7 as originally filed provides complete support for the amendments to the Specification, and as such, the amendments to the Specification submitted on July 24, 2009, does not introduce new matter. Accordingly, Applicants respectfully request that the objection to the Specification be withdrawn.

Claims 1-4, 6, 7, 9, 10, 12-16, and 18-21 were rejected under 35 U.S.C. § 112, first paragraph, as assertedly failing to comply with the written description requirement. During the telephonic interview, Examiner Swartz clarified that this rejection was related to the phrase

“only a billable data count” and the assertion that this phrase could be interpreted to exclude all other data. In response, Applicants have amended independent claim 1 to render this rejection moot. Claims 2-4, 6, 7, 9, 10, 12, 13-16, and 18-21 depend from claim 1. Accordingly, Applicants respectfully request that these rejections be withdrawn.

Claim 7 was rejected under 35 U.S.C. § 112, first paragraph, as assertedly failing to comply with the written description requirement. In particular, the Office Action asserted that support for claim 7 was only supported by the amendments to the Specification, which the Office Action asserted introduced new matter. As discussed above, however, the amendments to the Specification are supported by the original claim 7. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 1, 3-5, 9, 12-17, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Haumont in view of U.S. Patent No. 6,615,034 (hereinafter “Alloune”) in view of *Evolution of Charging and Billing Models for GSM and Future Mobile Internet Services* (hereinafter “Cushnie”), U.S. Patent No. 6,480,485 (hereinafter “Kari”), and U.S. Patent Application Publication No. 2002/0127995 (hereinafter “Faccinn”). Applicants respectfully traverse these rejections.

Applicants have amended claim 1 to recite, “providing by the SCP a volume limit threshold of said second type of data to the first SGSN.” The cited references fail to teach or suggest this limitation.

Applicants note that this limitation was previously recited in claim 8, which has been cancelled herein. Applicants assert, however, that the Office Action’s assertions that Haumont discloses a volume limit threshold in the SGSN (previous claim 1) and that Haumont discloses that the SCP provides the volume limit threshold to the SGSN (previous claim 8) are incorrect.

The Office Action asserted that paragraphs [0025], [0032]-[0035], [0040]-[0042], and [0057]-[0063] disclose these features. Office Action, page 10. During the telephonic interview, Examiner Swartz asserted that the statement, “In FIG. 2 the SCP receives an inquiry from an SGSN concerning a prepaid subscription in step 201,” in paragraph [0032] discloses that the SGSN has the volume limit threshold. Applicants respectfully assert that this statement fails to disclose that a volume limit threshold is provided to the SGSN.

This assertion is essentially asserting that “an inquiry . . . concerning a prepaid subscription” inherently means that the SGSN has a volume limit threshold. Applicants respectfully assert that this is not the case. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” MPEP § 2112 (citations omitted). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *Id.* (citations omitted). Furthermore, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Id.* (citations omitted).

In this case, simply because the SGSN transmits an *inquiry* from the SGSN to the SCP regarding a prepaid subscription does not necessarily require that the SGSN have a volume limit threshold. In particular, an inquiry does not necessarily include a volume limit threshold. In the event that this position is maintained, Applicants respectfully request that the Examiner provide

a basis in fact and/or technical reasoning that supports the position that a volume limit threshold necessarily flows from the inquiry.

Applicants note that paragraph [0032] of Haumont discloses a “predefined limit.” Even assuming, solely for the purpose of this response, that the predefined limit discloses Applicants’ volume limit threshold, this information is in the SCP and there is absolutely no disclosure in Haumont that the SCP provides the predefined limit to any other node, much less the SGSN. Haumont, the primary reference, explicitly teaches that it is the SCP that “monitors the balance of the account when the PDP context (and the set of services used) allows services charged from the subscription.” Haumont, paragraph [0033]. Haumont goes on to explain that the SCP triggers the deactivation of the PDP context when the balance of the prepaid account reaches the limit. *Id.* Because Haumont discloses that the SCP monitors and triggers the events, there is simply no reason for the SCP to provide the predefined limit to another node.

Applicants further note that “when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel *may not dissect* a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.” MPEP § 2106 (emphasis added). When considered as a whole, claim 1 recites a method in which the SCP provides a volume limit threshold to the SGSN; the volume limit threshold is provided to the GGSN; the GGSN accumulates a billable data count; the GGSN provides the billable data count to the SGSN, and the SGSN provides the billable data count to the SCP. To show these features, the Office Action combines five references. While Applicants acknowledge that there is no limit to the number of references that may be combined, Applicants assert that the combination must not be done in a manner in which the claim is dissected.

In this case, the Office Action has not cited any reference that shows (1) the SCP providing a volume limit threshold to the SGSN, (2) the volume limit threshold being provided to the GGSN, (3) the GGSN providing the billable data count to the SGSN, or (4) the SGSN providing the billable data count to the SCP. Rather, the Office Action dissected each of these to find the data in one reference and a general assertion that the various nodes communicate with each other and *could* have communicated such data between the recited nodes. However, that is not the test for patentability under 35 U.S.C. § 103(a). “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” MPEP § 2145 (citations omitted). Thus, the question is not whether or not the volume limit threshold “could” have been transmitted from the SCP to the SGSN to the GGSN, or whether the billable data count “could” have been transmitted from the GGSN to the SGSN to the SCP, but rather what would the combined teachings of the references have suggested to those of ordinary skill in the art.

Applicants respectfully submit that one of ordinary skill in the art reading the cited references would not have been motivated to perform the method as recited in Applicants’ claim 1. This is particularly true given that Haumont, the primary reference, explicitly teaches that it is the SCP that “monitors the balance of the account when the PDP context (and the set of services used) allows services charged from the subscription.” Haumont, paragraph [0033]. Haumont goes on to explain that the SCP triggers the deactivation of the PDP context when the balance of the prepaid account reaches the limit. *Id.* Given these explicit teachings of Haumont, it is clear that the cited references would not have suggested to one of ordinary skill in the art to perform the method as recited in Applicants’ claim 1.

In view of the above amendments and remarks, Applicants respectfully request that the rejection of claim 1 be withdrawn. Claims 2-4, 6, 7, 9, 10, 12-16, and 18-21 depend from and add further limitations to claim 1. Accordingly, Applicants respectfully request that the rejections of these dependent claims be withdrawn as well.

In view of the above, Applicants submit that the claims are in condition for allowance. No new matter has been added by this amendment. If the Examiner should have any questions, please contact Applicants' Attorney, Roger C. Knapp, at 972-732-1001. The Commissioner is hereby authorized to charge any fees due in connection with this filing, or credit any overpayment, to Deposit Account No. 14-1315.

Respectfully submitted,

July 6, 2010
Date

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